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HM12/0203

EXAMINER	
NELSON, A	
ART UNIT	PAPER NUMBER
1649	26

DATE MAILED: 02/03/00

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run \_\_\_\_\_ or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed \_\_\_\_\_ has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: 112, SECOND REJECTIONS INTRODUCED IN NEW CLAIMS (CLAIMS 27-31)  
LACK PROPER INTERFERENT BASIS (CLAIMS 31 AND 39 ARE INDEFINITE  
BECAUSE IT IS NOT CLEAR WHERE THE TERMINATOR IS LOCATED ON  
THE EXPRESSION CASSETTE.

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☒ ~~will be~~ <sup>has been</sup> entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: \_\_\_\_\_  
Claims objected to: \_\_\_\_\_  
Claims rejected: \_\_\_\_\_

*Amy Nelson*  
AMY NELSON  
PATENT EXAMINER

- However:  
☒ Applicant's response has overcome the following rejection(s): REJECTIONS UNDER 102(E) AND 103(A)

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because 112 first  
rejections (written description and scope) maintained because Applicant has not  
other isolated anti-bacterial genes or taught how to isolate other anti-bacterial
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other \* genes from a Diptera insect, other than sarcotoxin 1a gene. Also Applicant does  
not teach which other anti-bacterial genes would provide anti-fungal effect in transgenic  
plants in view of the single example and unexpected results of Applicant, undue trial and  
error experimentation would be required to identify other genes which could be used  
PTOL-303 (REV. 5-89) in the claimed methods and transgenic plants.